



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,667	10/22/2001	Joshua Miles Chase	104348	5068
76863	7590	02/09/2010		
Kraguljac & Kalnay 4700 ROCKSIDE ROAD SUMMIT ONE, SUITE 510 INDEPENDENCE, OH 44131				
EXAMINER				
CHANKONG, DOHIM				
ART UNIT		PAPER NUMBER		
2452				
NOTIFICATION DATE		DELIVERY MODE		
02/09/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mary@kkpatent.com
ptomail@kkpatent.com

Office Action Summary

Application No.

10/029,667

Applicant(s)

CHASE ET AL.

Examiner

DOHM CHANKONG

Art Unit

2452

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-49 and 51-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-49 and 51-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This non-final rejection is in response to Applicant's request for continued examination which was filed on 11/18/2009. Claims 43, 48, and 54 are amended. Claim 50 is cancelled. Claims 55-58 are newly added. Claims 1-42 were previously cancelled. Accordingly, claims 43-49 and 51-58 are presented for further examination.

I. CONTINUED EXAMINATION UNDER 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/2009 has been entered.

II. RESPONSE TO ARGUMENTS

A. Claims 43-49 and 51-54

Applicant's arguments with respect to claims 43-49 and 51-54 have been carefully considered but are not persuasive because the limitations are not supported by Applicant's specification. The examiner had previously indicated that the new limitations overcame the cited prior art but this indication presumed that the limitations met all requirements under § 112, first paragraph.

After carefully reviewing Applicant's specification, the examiner could not find written support for the new limitations as further explained in the following § 112, first paragraph rejection. Therefore, the limitations do not overcome the cited prior art.

B. Claims 55-58

The previous action objected to claim 50 (which depended on dependent claim 48) as containing allowable subject matter. Accordingly, Applicant has rewritten the claim in independent format to include the limitation of claim 50 and limitations of all intervening claims.

However, this objection was premised on the limitation meeting all requirements under § 112, first paragraph. After carefully reading Applicant's specification, the examiner now believes that certain subject matter are not supported by Applicant's specification and therefore constitute new matter. The examiner apologizes for not expeditiously raising this rejection when the limitation was first introduced.

III. CLAIM REJECTIONS - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A. Claims 43, 48, 54, and 55 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 43, 48, and 54

Specifically, claims 43, 48, and 54 disclose a limitation that recites “transmitting the redirection information and a command...wherein the command controls the requesting device to issue a first request for the initial content based on the first redirection code and a second request for the secondary content based on the second redirection code.” Contrary to the claimed limitation, Applicant’s specification does not describe controlling the requesting device to retrieve both the initial and second content using a *single* command.

Instead, Applicant’s specification using two commands to perform the claimed feature. For example, Applicant’s figure 3 discloses two separate redirect commands 154 and 158 which control the requesting device to issue a request for initial content 159 and secondary content 156. Applicant’s specification further explains the use of controlling the communications device using two commands:

According to one embodiment of the invention, the redirection information message 152 also includes the address of the originally-requested address and content filename. In particular, the universal resource locator (URL) address provided as part of the redirection information 152 is made up of the address for the secondary content source 160 and content name, followed by a question mark which is used as a delimiter, then followed by the address and content name of the originally-requested content appended afterward, for example, <http://www.scs.com/ad-page?www.ics.com/home-page>. *By executing the first redirection command 154 using this address, the client computer system 130 requests secondary content 165 from the secondary content source 160.*

Once the secondary content 165 has been obtained, the secondary content source 160 uses the address of the originally-requested initial content 145, e.g., www.ics.com/home-page which the communications device 110 provided to it as part of the initial redirection information message 152, to generate secondary redirection information 156. The secondary content source 160 then sends the information 156 to the client computer system 130. *The secondary content source 160 can then send an HTTP redirection code 302 command to the client computer 130 that, in turn, causes the client computer 130 to initiate a second redirection command 158, this time, to obtain the initially requested initial content 145 from the initial content source 140.* (emphasis added) [pg. 14 «lines 5-22»]

It is clear from the foregoing description that the command being sent with the redirection information (that includes the first and second redirection codes) is a command to request secondary content only. Other sections of the specification describe the same feature [pg. 19 «lines 24-29»: after displaying the secondary content, transmitting a second command to retrieve the initial content | pg. 20 «line 26» to pg. 21 «line 3»].

The examiner could not find any written support for the limitation reciting that a single command controls the requesting device to issue both a first and second request for initial and secondary content respectively. Thus, claims 43, 48, and 54 are rejected for failing to comply with the written description requirement of § 112, first paragraph.

Claim 55

Claim 55 contains a limitation reciting "providing a command to the requesting device, where the command controls the requesting device to concurrently retrieve the initial content and the secondary content based, at least in part, on the redirection information." This limitation is similar to the limitations discussed above. Therefore, claim 55 is rejected for at least the same reasons articulated above with respect to claims 43, 48, and 54.

There is no description in Applicant's specification of a single command that forces a requesting device to concurrently retrieve initial and secondary content. Applicant's specification does provide that a requesting device have "concurrent access to the secondary content and the initial content" but this does not mean that the content was retrieved concurrently.

If Applicant disagrees with either of these rejections, the examiner requests that Applicant cite specific sections in the specification which provide written support for the limitations.

IV. CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

A. Claim Interpretation for claims 43, 48, 54, and 55

As discussed above, claims 43, 48, 54, and 55 contain a limitation which is not supported by Applicant's specification. For purposes of this action, the limitation will be interpreted consistent with the functionality described in the specification which describes using two different commands for retrieving initial content and secondary content.

- B. Claims 43-47 and 52-54 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Schmid* et al, U.S. Patent No. 6.438.578 [*"Schmid"*], in view of *Gupta* et al, U.S. Patent No. 6.487.538 [*"Gupta"*], in further view of *Bandera* et al, U.S. Patent No. 6.332.127 [*"Bandera"*].**

All citations are to *Schmid* unless otherwise noted.

Claims 43 and 54

As to claims 43 and 54, *Schmid* as modified by *Gupta*, *Bandera*, and *Subramaniam* discloses a method performed in an intercepting communications device, the method comprising:

maintaining, in the intercepting communications device, access to a plurality of second content addresses, where a second content address identifies secondary content located at a secondary content source [column 6 «lines 41-56» & *Gupta*, column 10 «lines 32-40»];

intercepting an initial request [Figure 1 «item 24» | column 9 «lines 65-67» where : interception means intercepts a packet intended for the requested information source | column 10 «lines 17-21»], for initial content made by a requesting device before the initial request arrives at an intended destination, the intended destination being an initial content source [column 9 «line 65» to column 10 «line 11»];

extracting at least one request criteria from the intercepted initial request [*Bandera*, Fig. 3 «item 102, 104»: location information | Fig. 2 «item 23»: location information part of request header | column 7 «lines 15-18»];

creating redirection information by processing the at least one request criteria to determine an identity of secondary content to be retrieved by the requesting device [column 6 «lines 48-50» | *Bandera*, Fig. 7 «item 104»], wherein the redirection information includes a first redirection code and a second redirection code [column 6 «lines 8-28 and 41-44» where :

Schmid's request instructions for the requested information and the supplemental information read on Applicant's redirection code]; and

transmitting the redirection information and a command to the requesting device without transmitting secondary content from the intercepting communications device to the request device [column 6 «lines 41-44» : *Schmid*'s ad insertion server transmits format and request instructions which cause the client to request the supplemental information];

wherein the command controls the requesting device to issue a first request for the initial content based on the first redirection code and a second request for the secondary content based on the second redirection code¹ [column 6 «lines 3-21 and 41-56»: a command for controlling the requesting device to request for initial content and a second command that controls the device to request supplemental content].

As indicated in the foregoing mapping, *Schmid* does not expressly disclose (1) maintaining access to the network addresses for those pieces of supplemental information and (2) does not expressly disclose an intercepting device extracting request criteria from the intercepted request.

1. While *Schmid* discloses maintaining access to supplemental information, *Gupta* further discloses maintaining access to network addresses for supplemental information.

While *Schmid* discloses an intercepting device that maintains access to supplemental information, *Schmid* does not expressly disclose maintaining access to the network addresses for those pieces of supplemental information. However, it is inherent that the supplemental information has associated network addresses as further illustrated by *Gupta*. Like *Schmid*,

¹ As indicated above, this limitation is interpreted as referring to two separate commands and not a single command.

Gupta is directed to a system for intercepting requests for information and retrieving supplemental content from a supplemental content source, such as an ad server [Fig. 4a | Fig. 5]. *Gupta* further discloses a proxy that intercepts the client requests and maintains access to secondary addresses by caching the secondary content within the proxy [abstract: “advertisements may be stored in the proxy cache” | Fig. 4a | column 10 «lines 32-40»: “URL information specifying the advertisements for proxy 402 to fetch from the web server for the advertiser”].

Therefore, it would have been obvious to one of ordinary skill in the art to have modified *Schmid*'s ad insertion machine to have maintained access to the supplemental content addresses as taught by *Gupta*. Such a modification is an example of using a known technique (*Gupta*'s proxy cache storing secondary content) to improve similar systems (*Schmid*'s intercepting server) in the same way (*Schmid*'s server improved so that it caches the secondary content and their URLs). See MPEP § 2143.

2. *Bandera discloses an intercepting device extracting request criteria from an intercepted request.*

Also, while *Schmid* does disclose that retrieved secondary content are “related” to the intercepted request, *Schmid* does not expressly disclose an intercepting device extracting request criteria from the intercepted request. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Bandera*.

Like *Schmid*, *Bandera* discloses a system for providing secondary content “related” to a client's request. While *Schmid* is silent as to how this process is carried out, *Bandera* further discloses extracting criteria from a client's request [Fig. 3 «item 102, 104»: location information | Fig. 2 «item 23»: location information part of request header | column 7 «lines 15-18»].

It would have been obvious to one of ordinary skill in the art to have modified *Schmid* to include *Bandera*'s extraction functionality. Such a modification is an example of using a known technique (*Bandera*'s extraction of criteria to select related advertisements) to improve similar systems (*Schmid*'s related advertisements) in the same way (*Schmid*'s system improved so that the advertisements are directly related to a user's request and location). See MPEP § 2143.

Claim 44

Schmid as modified by *Gupta* does not expressly disclose extracting the at least one request criteria from at least one protocol header and matching the extracted request criteria to at least one of the plurality of secondary content addresses. However, such a feature was well known in the art at the time of Applicant's invention.

For example, *Bandera* the claimed features. Specifically, *Bandera* discloses extracting a request criteria from the least one protocol header on the intercepted initial request [column 6 «lines 57-60» | column 7 «lines 9-17» : location information is conveyed within the HTTP header]. *Bandera* also discloses matching the at least one extracted requested criteria to at least one of the plurality of secondary content addresses [column 7 «lines 20-27» : plurality of advertising objects that are mapped to location information].

It would have been obvious to one of ordinary skill in the art to have modified *Schmid* to include the extraction and matching functionality as taught in *Bandera*. One would have been motivated to adapt *Schmid* as *Bandera* teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

Claim 45

Schmid as modified by *Gupta* does not expressly disclose the matching feature in claim 44 further includes determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria or capturing an address from the at least one of the plurality of secondary content addresses. However, these features were well known in the art at the time of Applicant's invention.

Bandera discloses both:

determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria [column 7 «lines 24-27» : lookup table with associations between advertising objects and location information]; and

capturing an address from the at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria [column 7 «lines 28-40»].

It would have been obvious to one of ordinary skill in the art to have modified *Schmid* with *Bandera*'s teachings of identifying secondary content addresses that are mapped to the requests in order to tailor the secondary content to user interests. One would have been motivated to adapt *Schmid* as *Bandera* teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location).

Claim 46

Schmid as modified by *Gupta* does not expressly disclose identifying at least one of the plurality of secondary content addresses including at least one of identifying content based on a source, geographic, or content indication related to the at least one extracted request criteria.

Bandera discloses identifying content related to at least one source indication from the at least one extracted request criteria, that has at least one geographic indication related to at least one geographic location of the communications device or from the at least one extracted request criteria [column 7 «lines 32-40»], that has at least one geographic indication related to at least one geographic indication from the at least one extracted request criteria, and related to at least one initial content indication from the at least one extracted request criteria [Fig. 3 | Fig. 7]. It would have been obvious to one of ordinary skill in the art to have modified *Schmid* with *Bandera*'s teachings of identifying secondary content addresses related to the geographic location of the communications device. One would have been motivated to adapt *Schmid* as *Bandera* teaches that such functionality provides the ability to provide relevant advertisements to a user based on the extracted criteria (location and time of day).

Claim 47

Schmid as modified by *Gupta* and *Bandera* discloses capturing at least one Internet address for at least one advertisement that is related to the at least one extracted request criteria, the at least one advertisement programmed to be displayed with respect to a display of the initial content [column 6 «lines 48-50»] where : *Schmid* does not expressly disclose extracting request criteria. However, *Schmid* discloses that the advertisements are "related in some way to the requested information." This teaching implies extracting from the requested information some

criteria in order to retrieve the related advertisements]. Also, see *Bandera* [column 7 «lines 15-27»].

Claim 52

Schmid as modified by *Thompson* and *Gupta* discloses:

determining the identity of the secondary content relative to at least one of a geographic indication, a source indication, and a content indication in the at least one request criteria extracted from the intercepted initial request [column 6 «lines 48-50»].

Claim 53

Schmid as modified by *Thompson* and *Gupta* discloses intercepting the initial request at an entry point to the Internet [Figure 1 «item 10»].

C. Claims 48, 49, 51, 55, and 56 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Schmid*, *Thompson*, and *Gupta*, in further view of in view of *Subramaniam et al*, U.S. Patent No. 6,081,900 [“*Subramaniam*”].

Claim 48

Schmid as modified by *Gupta*, *Bandera*, and *Subramaniam* discloses creating redirection information includes:

concatenating a first redirection code and the one second redirection code [*Subramaniam*, column 7 «lines 12-20 and 47-58»]; and

separating the first redirection code and the second redirection code by a delimiter [column 6 «lines 8-28 and 41-44» | *Subramaniam*, column 7 «lines 12-20 and 47-58»].

Schmid does not expressly disclose a delimiter. However, a delimiter is merely a character or series of characters to mark a boundary between regions in a data stream such as a within a packet. *Subramaniam* discloses that delimiters are well known in the art and are

necessary to enable a requesting device to differentiate between the request instructions for the requested information and the supplemental information.

Therefore, it would have been obvious to one of ordinary skill in the art to have modified *Schmid's* format and request instructions to include the delimiter as taught by *Subramaniam*. *Subramaniam* discloses that the delimiter enables two different URLs to be sent as a single redirect link.

Claims 49 and 56

As to claims 49 and 56, *Schmid* as modified by *Thompson*, *Gupta*, and *Subramaniam* discloses:

including an address of the initial content source in the first redirection code [column 5 «lines 28-35» | *Subramaniam*, column 7 «lines 12-20 and 47-58»]; and

including an address of the at least one secondary content source in the second redirection code [column 6 «lines 41-47» | *Subramaniam*, column 7 «lines 12-20 and 47-58»].

Claim 51

Schmid as modified by *Thompson* and *Gupta* does not expressly disclose the delimiter separating the first code and the second code indicates to the requesting device an existence of a secondary content condition. However, such a feature was well known in the art at the time of Applicant's invention. For example, *Subramaniam* discloses providing a delimiter to be detected by the requesting device, such detection indicating to the requesting device an existence of a secondary content condition [column 7 «lines 12-20 and 47-58»]. It would have been obvious to one of ordinary skill in the art to have modified *Schmid's* system to include the delimiter feature

as taught in *Subramaniam*. *Subramaniam* discloses that the delimiter enables two different URLs to be sent as a single redirect link.

Claim 55

Claim 55 is rejected for at least the same reasons set forth for the rejection of claims 43, 48, and 54.

D. Claim 57 and 58 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid, Thompson, and Gupta, in further view of in view of Subramaniam et al, U.S. Patent No. 6.081.900 ["Subramaniam"].

Claim 57

Schmid as modified by *Bandera*, *Thompson*, *Gupta*, and *Subramaniam* discloses:
extracting a request criteria from the least one protocol header on the intercepted initial request [*Bandera*, column 6 «lines 57-60» | column 7 «lines 9-17» : location information is conveyed within the HTTP header]; and

matching the at least one extracted requested criteria to at least one of the plurality of secondary content addresses [column 7 «lines 20-27» : plurality of advertising objects that are mapped to location information].

See rejection of claim 44 for motivation to combine *Bandera* and *Schmid*.

Claim 58

Schmid does not expressly disclose the matching feature in claim 44 further includes determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria or capturing an address from the at least one of the plurality of secondary content addresses. However, these features were well known in the art at the time of Applicant's invention.

Bandera discloses both:

determining desirable secondary content by identifying at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria [column 7 «lines 24-27» : lookup table with associations between advertising objects and location information]; and

capturing an address from the at least one of the plurality of secondary content addresses that maps to content related to the at least one extracted request criteria [column 7 «lines 28-40»].

See the rejection of claim 45 for motivation to combine *Bandera* and *Schmid*.

V. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452